

**REMARKS**

The Office Action issued February 14, 2003 has been carefully considered and this Amendment prepared in response. Applicant respectfully requests reconsideration of the present application in view of the foregoing amendments and in view of the following remarks.

Claims 2 and 29 are requested to be cancelled. Claims 1, 3-4, 7-8, 10-11, 13-15, 17-19, 22-25, 27 and 30-31 are currently being amended. Therefore, claims 1, 3-28, and 30-32 are now pending in the application. A detailed listing of all claims that are, or were, in the application, irrespective of whether the claims remain under examination in the application, are presented, with an appropriate defined status identifier.

In the Office Action, claim 7 was rejected under 35 U.S.C. § 112, first paragraph as containing subject matter which was not described in the specification; claims 1-19 and 21-26 were rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent 4,786,154 to Fantone et al, claim 20 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Fantone in view of U.S. Patent No. 6,217,519 B1 to Grund, and claims 27-32 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Fantone in view of U.S. Patent No. 5,307,202 to Marino et al. Also, the drawings were objected to under 37 C.F.R. 1.83(a) for not showing every feature specified in the claims.

**New Figure 4 Resolves Rejection of Claim 7 And Objections To The Drawings**

New figure 4 illustrates the configuration disclosed in the specification in paragraph [0012] and in claim 7. Since the figure illustrates what was already disclosed in the specification, no new matter is added. The specification is amended to add a summary description of new FIG. 4 and to refer to the figure in paragraph [0012].

As recited in paragraph [0012], light from the specimen is received directly on the image measuring unit without passing through refractory optics. One of ordinary skill in the art would understand that such an image measuring unit must have a direct, i.e., non-refracted, view of the image. Since a direct viewing image measuring unit is a simpler configuration than a unit receiving a refracted image (i.e., no refracting elements and no

structure to hold and align such elements), one of ordinary skill in the art could make and use the invention recited in claim 7 without undue experimentation.

Since one of ordinary skill in the art would understand from the disclosure how to make and use the invention recited in claim 7, Applicant submits that claim 7 is sufficiently enabled by the specification. Accordingly, withdrawal of the rejection of claim 7 under 35 U.S.C. § 112, first paragraph is respectfully requested.

**Fantone Does Not Disclose The Structure Recited In Amended Claims 1, 22 and 27**

Claim 1 is amended to incorporate the subject matter of claim 2, which is cancelled, namely that the image measuring unit measures a brightness and that the controller is configured to adjust a brightness of the image signal. Similar amendments are made to independent claims 22 and 27. Other claims are then amended to render them consistent with the amended independent claims. As amended, claims 1 and 27 recite an image measuring unit that measures the brightness of the image and a controller/superimposition apparatus that is configured to adjust the brightness of the image signal based on the measured brightness of the image. Support for these amendments is found in the last sentence of paragraph [0009].

Fantone does disclose a microscope with an image injection beam splitter for injecting an image which overlays a specimen image. However, Fantone does not disclose a brightness sensor for sensing the overall brightness of the image. Fantone also does not disclose a mechanism for adjusting the basic brightness of an image (e.g., an image on an LCD or monitor) such as by regulating an illuminating light source. Thus, Fantone does not regulate the overall basic brightness of the injected image. Instead, in contrast to the present application, Fantone amends the specimen image (such as by overlaying another image like an image of diseased tissue) or enhances it and re-injects the image into the optical path in the enhanced format.

Thus, Fantone fails to teach structure for measuring and automatically adjusting the overall brightness of the injected image non selectively depending on the overall (basic) brightness of the specimen image.

In other words claims 1, 22 and 27 recite structure and a method for adjusting a light source for illuminating an image, which is very different from the structure and method disclosed in Fantone which adjusts some pixels or the information of the image.

Since Fantone fails to disclose structure recited in amended claims 1, 22 and 27, Applicant respectfully submits that these claims are not anticipated by that reference. According, withdrawal of the rejection of those claims under 35 U.S.C. § 102(b) is respectfully requested. Since claims 3-19, and 23-26 depend from allowable claims 1 and 22, respectively, Applicant submits that these claims are also not anticipated by Fantone, and withdrawal of the rejections of these claims under 35 U.S.C. § 102(b) is also respectfully requested.

#### **Combinations Of Fantone With Other References Fail To Disclose Claims 20 and 27-32**

As discussed above, Fantone fails to disclose the structure or method recited in amended claims 1, 22 and 27 for measuring the brightness of the image and automatically adjusting the brightness. None of the other references overcome this deficiency. Accordingly, Applicant submits that claims 20 and 27-32 are patentable over the combination of Fantone with either Grund or Marino. Therefore, withdrawal of the rejections of these claims under 35 U.S.C. § 103(a) is respectfully requested.

#### **Conclusion**

Applicant believes that the present application is now in condition for allowance. Favorable reconsideration of the application as amended is respectfully requested.

The Examiner is invited to contact the undersigned by telephone if it is felt that a telephone interview would advance the prosecution of the present application.

The Commissioner is hereby authorized to charge any additional fees which may be required regarding this application under 37 C.F.R. §§ 1.16-1.17, or credit any overpayment, to Deposit Account No. 19-0741. Should no proper payment be enclosed herewith, as by a check being in the wrong amount, unsigned, post-dated, otherwise improper or informal or even entirely missing, the Commissioner is authorized to charge the unpaid amount to

Deposit Account No. 19-0741. If any extensions of time are needed for timely acceptance of papers submitted herewith, applicant hereby petitions for such extension under 37 C.F.R.

§1.136 and authorizes payment of any such extensions fees to Deposit Account No. 19-0741.

Respectfully submitted,

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